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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,054	10/03/2000	Albrecht Dorschner	Beiersdorf 656-KGB	4744

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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/679,054	Applicant(s) DORSCHNER ET AL.	
	Examiner Marina Lamm	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 7-11 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 7-11 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/25/04 has been entered.
2. Claims pending are 5, 7-11 and 16-20. Claims 5, 16 and 17 have been amended. Claim 20 is new.

Double Patenting

3. The provisional obviousness-type double patenting rejection of Claims 5, 7-11 and 16-19 as being unpatentable over claims 5-18 of copending Application No. 10/365,847 is maintained for the reasons of the record.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 5, 7-11 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 16, 17 and those dependent thereon are viewed as indefinite because they recite the limitation "oil-in-water (O/W) microemulsion composition, consisting essentially of", but fail to recite an oil phase and a water phase which are essential components of the oil-in-water composition.

Claim 20 (new) recites the limitation "composition of claim 1" in line 1. There is insufficient antecedent basis for this limitation in the claim since claim 1 has been cancelled. For the purpose of examination, Claim 20 is being interpreted as dependent from Claim 5.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (US 5,610,130) in view of either Moore et al. (US 6,063,746) or Gers-Barlag et al. (US 5,876,702).

Thomas et al. teach oil-in-water microemulsions containing 0.1-20% of ethoxylated glycerol-based non-ionic surfactants and 0.5-20% of insect repellents such as DEET (N,N-diethyl-m-toluamide). See Abstract; col. 4, lines 1-7; col. 5, lines 33-34. The Thomas et al. reference does not teach the specific emulsifiers of the instant claims. However, the claimed emulsifiers are well known in the emulsion art and are conventionally used for the same art-recognized purpose as the ethoxylated glycerol-based non-ionic emulsifiers of Thomas et al., i.e. for the formation and stabilization of

oil-in-water emulsions. Thus, Moore et al. teach employing ceteareth-12 and ceteareth-20 "to enable an emulsion to be formed when the oil and water phases are mixed". See col. 3, lines 49-52. Similarly, Gers-Barlag et al. teach using ceteareth-12 in oil-in-water microemulsions. See Examples. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use ceteareth-12 and/or ceteareth-20 of Moore et al. or Gers-Barlag et al. for emulsions of Thomas et al. with a reasonable expectation of obtaining a stable oil-in-water microemulsion having the same or similar properties as set forth in the Thomas et al. reference. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

8. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (US 5,610,130) in view of either Moore et al. (US 6,063,746) or Gers-Barlag et al. (US 5,876,702) and further in view of Klier et al. (US 4,127,672).

Thomas et al. in view of either Moore et al. or Gers-Barlag et al. applied as above. While teaching DEET, the Thomas et al. reference does not teach the insect repellents of the instant claims. However, Klier et al. teach that insect repellents such as DEET, when applied to a plastic object, can damage plastic by partially dissolving or swelling it. See col. 1, lines 26-37. Klier et al. teach improved repellents such as 3-(N-n-butyl-N-acetyl) aminopropionic ethyl ester, which "do not attack or damage plastic objects even after prolonged contact time." See col. 1, lines 42-47; col. 2, lines 29-37.

The improved propellants of Klier et al. are suitable for using in cleaning compositions. See col. 6, lines 67-68; col. 7, lines 1-2. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cleaning compositions of Thomas et al. such that to employ 3-(N-n-butyl-N-acetyl) aminopropionic ethyl ester instead of DEET as an insect repellent. One having ordinary skill in the art would have been motivated to do this to obtain insect repellent cleaning compositions which can be used to clean plastic objects without damaging the plastic even after prolonged contact time as suggested by Klier et al.

9. Claims 5, 7-11 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al. (US 5,876,702) in view of Stewart (US 6,159,452), of record.

Gers-Barlag et al. teach cosmetic sunscreen o/w microemulsions containing emulsifiers of the instant claims, e.g. cetareth-12. See Abstract; Examples. The compositions of Gers-Barlag et al. may contain vitamin E acetate, glycerol, and other cosmetic agents. See col. 15, line 59; col. 16, lines 12-16, 41. The reference does not explicitly teach insect repellents of the instant claims. However, Stewart teaches using insect repellents such as DEET and/or 3-[N-Butyl-N-acetyl]-aminopropionic acid ethyl ester in an amount of 7-33%, in cosmetic sunscreen compositions for providing protection against both insects and sun radiation for people who live, work or play outdoors. See col. 1, lines 27-62; col. 4, lines 40-67. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

modify the sunscreen microemulsion compositions of Gers-Barlag et al. such as to add insect repellents. One having ordinary skill in the art would have been motivated to do this to obtain compositions which would provide protection against both insects and sun radiation for people who live, work or play outdoors as suggested by Stewart.

Response to Arguments

10. Applicant's arguments filed 10/25/04 have been fully considered but they are not persuasive.

11. In response to the Applicant's arguments that the instant claims are not anticipated by Thomas et al., it is noted that the anticipation rejection has been withdrawn previously. See Advisory Action mailed 7/8/04.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,792,465; US 6,333,362; US 6,607,733.

13. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary L. Kunz
GARY KUNZ
SUPERVISORY PATENT EXAMINER
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12/11/04